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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/566,542

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Philip Caunt

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EXAMINER

HUANG, CHENG YUAN

ART UNIT

PAPER NUMBER

1787

NOTIFICATION DATE

DELIVERY MODE

06/11/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

euspto@slspatents.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/566,542	<b>Applicant(s)</b> CAUNT ET AL.	
	<b>Examiner</b> CHENG HUANG	<b>Art Unit</b> 1787	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 14, and 17-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 14 and 17-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>20100317</u> .  | 6) <input type="checkbox"/> Other: _____                          |

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### DETAILED ACTION

1. In light of the new grounds of rejection with respect to claim 5, which was inadvertently not rejected in the previous office action, the following action is non-final.

#### *Claim Rejections - 35 USC § 103*

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1-4, 6-10, 14, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Caselli et al. (EP 1146111) in view of Stevens (U.S. Patent No. 5,712,237) and Scheuing et al. (U.S. Patent Application Publication No. 2003/0220223).

5. Regarding claims 1 and 14, Caselli et al. teaches a composition for disinfecting a space (See Abstract) comprising one or more essential oils or essential oil components (paragraph

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[0033]), and a mixture of volatile and non-volatile solvents (paragraphs [0023], [0110], and [0124]) absorbed on a carrier (paragraph [0139]).

6. Caselli et al. fails to teach the claimed percent weight ratio of volatile to non-volatile solvent.

7. However, Stevens teaches a composition (See Title) comprising a mixture of volatile and non-volatile solvents, wherein the claimed percent weight ratio of volatile to non-volatile solvent is in the range of 50:3 to 1:15 (col. 6, lines 30-35, col. 10, lines 50-52), which encompasses the claimed range of 3:1 to 1:3.

8. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose a percent weight ratio, including those claimed, for the volatile to non-volatile solvents of Caselli et al. to control the distillation, compatibility, likelihood of forming azeotropes with other cosolvents, solubility with hydrophilic stains and contaminants, and cost (Stevens, col. 6, lines 24-30, col. 10, lines 56-67).

9. Caselli et al. fails to teach the claimed carrier material.

10. However, Scheuing et al. teaches a composition for disinfecting a space (paragraph [0042]) wherein carrier is a non-woven material and the non-woven carrier is a combination of cellulose and polypropylene (paragraph [0072]).

11. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose a non-woven cellulose and polypropylene combination for the carrier of Caselli et al. as modified by Stevens as an effective absorbent material (Scheuing et al. paragraphs [0070]-[0074]).

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12. Regarding the limitation that the composition is for disinfecting a space and “vapor-producing” as presently claimed, applicants attention is drawn to MPEP 2111.02 which states that “if the body of a claim fully and intrinsically sets forth all the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention’s limitations, then the preamble is not considered a limitation and is of no significance to claim construction”. Further, MPEP 2111.02 states that statements in the preamble reciting the purpose or intended use of the claimed invention must be evaluated to determine whether the purpose or intended use results in a structural difference between the claimed invention and the prior art. Only if such structural difference exists, does the recitation serve to limit the claim. If the prior art structure is capable of performing the intended use, then it meets the claim.
13. It is the examiner’s position that the preamble does not state any distinct definition of any of the claimed invention’s limitations and further that the purpose or intended use, i.e. “vapor-producing” or “for disinfecting a space”, recited in the present claims does not result in a structural difference between the presently claimed invention and the prior art composition and further that the prior art structure which is a composition identical to that set forth in the present claims is capable of performing the recited purpose or intended use.
14. Regarding claims 2, 3, and 6, Caselli et al. teaches wherein the essential oil component is cinnamic aldehyde, cinnamic alcohol, and/or cinnamon oil (paragraph [0036]).
15. Regarding claim 4, Caselli et al. teaches wherein the essential oil component is eugenol (paragraph [0047]).

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16. Regarding claims 7 and 8, Caselli et al. teaches wherein the volatile solvent is an alcohol and wherein the alcohol is isopropanol (paragraph [0124]).

17. Regarding claim 9, Caselli et al. teaches wherein the non-volatile solvent is water (paragraph [0023]) .

18. Regarding claim 10, Caselli et al. teaches wherein the non-volatile solvent is glycol (paragraph [0111]).

19. Regarding claim 18, while Caselli et al. as modified by Stevens and Scheuing et al. does not disclose the size limitation as claimed, it is noted that limitations relating to size are not sufficient to patentably distinguish the present invention over the prior art. Furthermore, given that the structural laminate of Caselli et al. as modified by Stevens and Scheuing et al. would not perform differently than that claimed, the claimed structural laminate is not patentably distinctly from that of Caselli et al. as modified by Stevens and Scheuing et al., given that the courts have held that where the only difference between the prior art and the claims is a recitation of relative dimensions, there is no patentable distinction between the claims and the prior art (see MPEP 2144.04 IVA). Finally, it is noted one of ordinary skill would easily recognize the composite of the prior art could be sized to fulfill a desired end use.

20. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caselli et al. (EP 1146111) in view of Stevens (U.S. Patent No. 5,712,237) and Scheuing et al. (U.S. Patent Application Publication No. 2003/0220223), and further, in view of Julemont et al. (U.S. Patent No. 6,380,152)

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21. Caselli et al. as modified by Stevens and Scheuing et al. is relied upon as disclosed above.

22. Caselli et al. as modified by Stevens and Scheuing et al. fails to disclose wherein the essential oil component is tea tree oil.

23. However, Julemont et al. teaches a composition (col. 1, lines 56) comprising one or more essential oils (col. 2, line 48-col. 3, line 30) wherein the essential oil is tea tree oil (col. 3, line 3) and wherein the composition is absorbed on a carrier (col. 1, lines 48-51).

24. Given that Julemont et al. teaches essential oils including those of anise, clove, aniseed, lemongrass, lemon, lavender, and tea tree oil (col. 2, line 48-col. 3, line 30) and given that Caselli et al. teaches essential oils including those of anise, clove, aniseed, lemongrass, lemon, and lavender that act as proteins denaturing agents to exhibit antimicrobial activity and contribute to the safety profile when used to disinfect any surface, and impart pleasant odor to a composition without the need of adding a perfume, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one of the essential oils in the composition of Caselli et al. as a known functional equivalent of tea tree oil. Substitution of known components with other components that yield predictable results would have been obvious to one of ordinary skill in the art since predictable characteristics such as antimicrobial activity that may be used to disinfect surfaces. See MPEP 2144.06 II.

25. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caselli et al. (EP 1146111) in view of Stevens (U.S. Patent No. 5,712,237) and Scheuing et al. (U.S. Patent

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A3pplication Publication No. 2003/0220223), and further, in view of McCue et al. (U.S. Patent No. 5,403,587).

26. Caselli et al. as modified by Stevens and Scheuing et al. is relied upon as disclosed above.

27. Caselli et al. as modified by Stevens and Scheuing et al. fails to teach wherein the non-volatile solvent is a glycol wherein the glycol is (mono)propylene glycol.

28. However, McCue et al. teaches wherein the non-volatile solvent is a glycol wherein the glycol is (mono)propylene glycol (col. 4, lines 15-16).

29. It would have been obvious to one of ordinary skill in the art at the time of the invention to include (mono)propylene glycol as the glycol of Caselli et al. as a solubilizing and dispersing agent (McCue et al., col. 4, lines 4-11).

30. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caselli et al. (EP 1146111) in view of Stevens (U.S. Patent No. 5,712,237) and Scheuing et al. (U.S. Patent Application Publication No. 2003/0220223), and further, in view of Caunt et al. (EP 0965541)

31. Caselli et al. as modified by Stevens and Scheuing et al. is relied upon as disclosed above.

32. Caselli et al. as modified by Stevens and Scheuing et al. fails to teach wherein the carrier is amorphous silicon dioxide.

33. However, Caunt et al. teaches an antimicrobial a composition with a carrier of amorphous silicon dioxide (paragraphs [0001] and [0009]).



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34. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose the carrier of Caselli et al. as modified by Stevens and Scheuing et al. to be amorphous silicon dioxide for anti-microbial properties (Caunt et al., paragraph [0009]).

35. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Caselli et al. (EP 1146111) in view of Stevens (U.S. Patent No. 5,712,237) and Scheuing et al. (U.S. Patent Application Publication No. 2003/0220223), and further, in view of Hartman et al. (U.S. Patent Application Publication No. 2005/0106121).

36. Caselli et al. as modified by Stevens and Scheuing et al. is relied upon as disclosed above.

37. Caselli et al. as modified by Stevens and Scheuing et al. fails to teach wherein the carrier is a self-adhesive item or label.

38. However, Hartman et al. teaches a composition for disinfecting a space (paragraph [0016]) wherein the carrier is a self-adhesive item or label (paragraphs [0063] and [0065]).

39. It would have been obvious to one of ordinary skill in the art at the time of the invention to choose a self-adhesive item or label for the carrier of Caselli et al. as modified by Stevens and Scheuing et al. for generating desirable amounts of chlorine dioxide gas over a desirable period of time when exposed to water or water vapor to prevent or retard microbial growth within an atmosphere or within an enclosure for a sustained period of time and, therefore, be utilized to control microbial growth on items contained in a package (paragraphs [0016] and [0075]).

***Response to Arguments***

40. Applicant's arguments filed 22 April 2010 have been fully considered but they are not persuasive.

41. Applicants amended claim 1 to include the limitations of cancelled claims 13, 14, and 17. Claim 12 is also cancelled and the ratio of 3:1 to 1:3 instead of 10:1 to 1:10 is included in claim 1.

42. Applicants argue that "Caselli et al. does not disclose the ratio of volatile to non-volatile solvent as set forth in the claims as amended herein".

43. However, it is agreed and therefore Caselli et al. is combined with Stevens to teach the claimed limitation.

44. Applicants argue that "there is no disclosure of absorbing the composition onto a carrier".

45. However, it is agreed, which is why Caselli et al. is combined with Scheuing et al. to teach the claimed limitation.

46. Applicants argue with respect to Caselli et al. and Scheuing et al. that "the prior art is directed is only concerned with achieving a short-term effect" as opposed to the present invention being "advantageous because it provides a sanitizing effect over extended periods of time".

47. However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the claimed composition having a sanitizing effect over extended periods of time; composition not intended to be brought into contact with contaminated surface) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the

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specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHENG YUAN HUANG whose telephone number is (571) 270-7387. The examiner can normally be reached on Monday-Thursday from 8 AM to 4 PM.

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Callie Shosho, can be reached at 571-272-1123. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. H./

Cheng Yuan Huang  
Examiner, Art Unit 1787  
May 18, 2010

/Callie E. Shosho/

Supervisory Patent Examiner, Art Unit 1787